



JJGJr.:02-02

Paper 7

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FEB 22 2002

OFFICE OF PETITIONS

In re Application of
Silvers
Application No. 09/120,448
Filed: 22 July, 1998
Attorney Docket No. 4191.001

:
: DECISION REFUSING
: STATUS UNDER
: 37 C.F.R. 1.47(b)
:

This is a decision on the declaration/statement (treated herein as an incomplete petition under 37 C.F.R. §1.47(b)¹) filed on 22 July, 1998, however, the fee for such a petition was not paid until 20 December, 2001.²

The petition is **DISMISSED**.

NOTES:

- (1) Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)" and may include an oath or declaration executed by the inventors.
- (2) Failure to respond will result in abandonment of the application.
- (3) There will be no reconsideration thereafter.

BACKGROUND

The record indicates:

- this application was filed on 22 July, 1998, without an executed oath or declaration for the application, but with a declaration/statement by one Jonathan Star (Mr. Star),

¹ The regulations at 37 C.F.R. §1.47, in pertinent part:

§1.47 Correction of inventorship in a patent application, other than a reissue application.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §17(i), and the last known address of all of the inventors. The Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to all of the inventors at the addresses stated in the application and publish notice of the filing of the application in the *Official Gazette*. An inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

² Pursuant to Petitioner's authorization, the \$130.00 petition fee was charged to Deposit Account 08-2776.

as president of Webface, Inc., which claims a proprietary right in the instant application;³

- the declaration recites that, because of a conflict between Mr. Star and the allegedly recalcitrant inventor John Leroy Silvers (Mr. Silvers), a copy of the application was forwarded to Mr. Silvers through his counsel, however, no copy of the transmittal letter evidences such a transmittal of the entire application (specification, abstract, claim(s), drawing(s), oath/declaration) or the receipt thereof;
- the declaration/statement also recites that Mr. Silvers refused through his counsel Stephen J. Finta (Mr. Finta) to sign the oath/declaration, however, there is no correspondence from Mr. Finta to this effect;
- while the record sets forth the address of Mr. Silvers in 1998, because the Petitioner failed to take proper action as to a petition under 37 C.F.R. §1.47(b) until this late date, the record is silent as to Mr. Silver's current or most recently known address and Petitioner's effort to ascertain such information.

ANALYSIS

Petitioner has failed to establish that the inventor cannot be found to sign the declaration or continues to refuse to do so (the proof of the pertinent events must be made by a statement of someone with first hand knowledge of the events).

A copy of the application papers must be sent to the last known address of the non-signing inventor with a request that he sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor cannot be reached.

The submission must contain documentation evidencing that the entire application and the oath or declaration were sent to the inventors at his/her last known address. Such evidence should include a copy of the transmittal letter and a copy of the shipping waybill and the shipper's indication of delivery, refusal, or other non-delivery conditions.

An oath or declaration for the patent application in compliance with 37 C.F.R. §1.63 and §1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address. (An oath or declaration in compliance with 37 C.F.R. §1.63 and §1.64 signed by the Rule §1.47 applicant is required.)

Moreover, Petitioner's Counsel must set forth in his/her statement their attestation that he/she believes all of the information submitted to be correct--including the required foregoing items and the statement of the last known addresses of the inventors.

Further correspondence with respect to this matter should be addressed as follows:

³ The declaration/statement of Mr. Star also is accompanied by a copy of an assignment purportedly signed by Mr. Silvers before a Notary Public in the State of Florida on 7 October, 1997.

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read 'J. Gillon', with a long horizontal stroke extending to the right.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy